The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD L. SMITH,
LAVAUGHN F. WATTS, JR., and THOMAS R. GRIMM

Appeal No. 1999-2042
Application No. 08/568,777

ON BRIEF

Before SMITH, JERRY, FLEMING, and LALL, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-29, all the pending claims in the application.

The disclosed invention relates to a portable computer having an interface for direct connection to a portable telephone. In one embodiment of the invention, a portable

telephone (cellular in the present case) is constructed in such a fashion as to fit within a cavity in a portable computer. The portable telephone is physically connected to the portable computer by a latching mechanism and communicates with the portable computer by means of a computer/portable telephone interface. Physically and electrically connecting the portable telephone to the portable computer eliminates the need for a cable or tethered connection between a portable computer and a portable telephone. Several other embodiments of the invention are disclosed. A further understanding of the invention can be obtained by the following claim.

1. A computer, comprising:

a provision for user input;

a provision for output;

a microprocessor coupled to said user input and said output; and

an interface coupled to said microprocessor, said interface being directly connectable to a corresponding interface in a portable telephone

The examiner relies on the following references:

Hop	4,912,756	Mar. 27, 1990
Morris	5,020,090	May 28, 1991
Dent et al. (Dent)	5,581,597	Dec. 3, 1996 (filed May 19, 1995)

Claims 1-7, 13, 15-17, and 19-29 stand rejected under 35 U.S.C. § 102 as being anticipated by Hop.

Claims 8-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hop.

Claim 18 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hop in view of Dent.

Claims 12 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hop in view of Morris.

Rather than repeat the arguments of appellants and the examiner, we make reference to the briefs[1] and the answer for the respective details thereof.

OPINION

We have considered the rejections advanced by the examiner and the supporting arguments. We have, likewise, reviewed the appellants' arguments set forth in the briefs.

We affirm-in-part.

Rejections under 35 U.S.C. § 102

In the response to the rejection of claims 1-7, 13, 15-17, and 19-29 (answer at pages 3 and 4), appellants submit arguments

[1] A reply brief was filed as Paper No. 13 on March 8, 1999, and its entry was noted by the examiner on March 29, 2000, see Paper No. 15, without any further response.

in regard to each claim separately. With respect to claims 1 and 29, after discussing the Hop reference (brief at pages 6-8), appellants conclude, id. at 8, that:

> Thus, interface circuit 3 is not a part of CSE 4, not a part of cellular connector 28, not a part of handset 27, and not an integrated part of any "portable telephone" . . . . As a result, Hop fails to teach or suggest a computer having an interface that is "**DIRECTLY** connectable to a corresponding interface in a portable telephone", as required by Appellants' Claims 1 and 29.

The examiner responds, answer at pages 8 and 9, that "[t]his is correct yet these four devices are connected together to form a computer system. The examiner noted that there is nothing in the claim language requiring the four device to be physically one device." We agree with the examiner's position. Looking at Figure 2 of Hop, we find that the interface 3 and 28 is indeed directly connected to the portable computer PC1 via line 22. Even though line 29 and line 23, which also connect the interface to the computer PC1, do not directly connect the interface to the computer because of the presence of modem 24 in the two lines, the language of the claim does not preclude a partial indirect connection of the interface to the computer. We also note that, as observed by the examiner, claim language does not require interface being an integral part of the computer and physically

connected to the computer. Therefore, we sustain the anticipation rejection of claims 1 and 29 by Hop.

With respect to claims 2-7, appellants make the same argument for each claim. Additionally, appellants argue, with respect to claim 2, for example, brief at page 8, that "the Examiner argues that this feature is inherent in Hop's disclosure but fails to identify the location of the teaching for such inherency. As a result, the Hop reference fails to teach or suggest this further limitation in combination with the requirements of Claim 1." We note that:

> To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by person of ordinary skill." ***In re Robertson***, Slip Op 98-1270 (Fed. Cir. February 25 1999) ***citing Continental Can Co v. Monsanto Co.***, 948 F.3d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result for a given set of circumstances is not sufficient." Id. ***citing Continental Can Co v. Monsanto Co.***, 948 F.3d 1264, 1269, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991).

Here, the examiner has asserted that the claimed feature in claim 2, i.e., a keyboard, is inherent to a computer. We agree with the examiner that since an input means is inherent to a computer and a keyboard is a common input means, an artisan would recognize that Hop's computer necessarily possesses a keyboard.

Therefore, the burden shifts to appellants to disprove the examiner's assertion of inherency. While appellants have made a statement to oppose this assertion by the examiner, appellants have not shown why the computer PC1 in Hop would not possess a keyboard to provide an input to PC1. The same rationale applies to claims 3-7. Therefore, we also sustain the anticipation rejection of claims 2-7 by Hop.

With respect to claim 13, appellants simply state the limitations and the teachings of the Hop reference at pages 9 and 10 of the brief. However, appellants do not explain specifically why the teachings of Hop do not meet the limitations of claim 13 as asserted by the examiner on page 3 of the examiner's answer. 37 CFR § 1.192(c)(8)(iii). Therefore, we sustain the anticipation rejection of claim 13 by Hop.

With respect to claim 15 (brief at page 10), appellants argue that "[b]idirectional serial bus 22 fails to teach both 'at least one voice channel lead' and 'one command channel lead'." In the examiner's rejection of claim 15 (answer at page 4, and response to appellants' arguments in the answer at pages 9 and 10), the examiner contends that since port 20 as well as port 21 in Hop's PC1 are identified as RS232 connectors, the connecting line 22 must have the capability of a RS232 cable. The examiner

also points to a cable layout in Figure 3 of Hop to support this point of view. However, we find that the examiner's reliance on RS232 cable between the interface 3 and the portable computer 2 is misplaced. We, instead, agree with the appellants' position that the connecting line 22 in Figure 2 of Hop does not indeed have the claimed "at least one voice channel lead" and "one command channel lead." Since claims 16, 17, and 19-28 depend on claim 15, they also are not met by the Hop reference as contended by the examiner. Therefore, we do not sustain the anticipation rejection of claims 15-17 and 19-28 by Hop.

Rejections under 35 U.S.C. § 103

In response to the obviousness rejection of claims 8-11 (answer at pages 4 and 5), appellants argue, pages 14 and 15 of the brief, that "[t]he Examiner has . . . failed to provide evidence to show that an ordinary artisan would have been motivated to modify interface COM1 or COM2 in Hop to be in a cavity within portable computer 2 without the improper hindsight provided by Appellants' disclosure." With respect to each of these claims, the claimed feature requires that said interface is located within a cavity in said computer either partially or completely. We agree with appellants that the examiner has provided no evidence or a line of reasoning to modify Hop to have

the claimed cavity which will accommodate the interface either partially or completely. Therefore, we do not sustain the obviousness rejection of claims 8-11 over Hop.

With respect to claim 18, since it depends on claim 15, and the additional reference Dent used by the examiner, does not cure the deficiency noted above in regard to claim 15, we do not sustain the obviousness rejection of claim 18 over Hop and Dent.

With respect to claim 12, appellants argue that the combination of Morris and Hop does not meet the claimed limitations, brief at pages 17 and 18 and reply brief at pages 13 and 14. However, we find that, according to claim 1, a computer is defined to contain all the elements shown in Figure 2 of Hop including user input, output, microprocessor, and an interface coupled to cellular connector, said interface being directly connectable to a corresponding interface in a portable telephone. Furthermore, modem 24 is clearly within said computer and is coupled to the microprocessor. Therefore, Hop alone shows modem being within said computer in Figure 2 of Hop. Morris, even though it shows a modem within the body of the computer in Figure 8 and column 5, lines 1-3, is merely cumulative to the disclosure of Hop to meet the claimed limitations of claim 12. With respect to claim 14, Figure 2 of Hop clearly transmits and receives voice

and data signals while the computer and the portable telephone are connected together, as explained with respect to claim 1 above. Therefore, we sustain the obviousness rejection of claim 12 and its dependent claim 14 over Hop and Morris.

In conclusion, we have sustained the anticipation rejection of claims 1-7, 13 and 29 by Hop; we have sustained the obviousness rejection of claims 12 and 14 over Hop and Morris; we have not sustained the anticipation rejection of claims 15-17 and 19-28 by Hop; we have not sustained the obviousness rejection of claims 8-11 over Hop; and we have not sustained the obviousness rejection of claim 18 over Hop and Dent.

The decision of the examiner rejecting claims 1-29 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Jerry Smith
Administrative Patent Judge)
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Michael R. Fleming)
Administrative Patent Judge) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
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Parshotam S. Lall)
Administrative Patent Judge)

PSL:tdl

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Ronald O. Neerings
Texas Instruments Incorporated
P.O. Box 655474, M/S 3999
Dallas, TX 75265